UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,853	03/07/2000	Michael O'Doherty	584-1022	8975

23644 7590 02/16/2006

BARNES & THORNBURG, LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

EXAMINER	
PWU, JEFFREY C	

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/520,853	O'DOHERTY, MICHAEL	
	Examiner	Art Unit	
	Jeffrey C. Pwu	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 November 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Final Rejection has been withdrawn in view of Appeal Brief filed 11/25/2005. Any inconvenience is regretted.

Title

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitation "the computer software". There is insufficient antecedent basis for this limitation in the claim.

3. Regarding claim 17, the word "or" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

4. Claims 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18 is vague and indefinite because it is unclear how does the computer software code causes a second node to test the second node.

Claim 19 is vague and indefinite because it is unclear how does the computer software code causes said second node to collaborate with said first node to forward a call from the first to the second node.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 1-33 are rejected under 35 U.S.C. 102(a) as being anticipated by "ChaiTime: A System for Rapid Creation of Portable Next –Generation Telephony Services Using Third-Party Software Components", hereinafter ChaiTime.

ChaiTime teaches claims:

1. A method of transferring computer software code between a

first and a second node in a communications network, each of said nodes comprising a SIP client, said method comprising the steps of,

i) storing computer software code in a SIP message; (Fig.3 of page 25, Internet Telephony SIP/H323 Application)

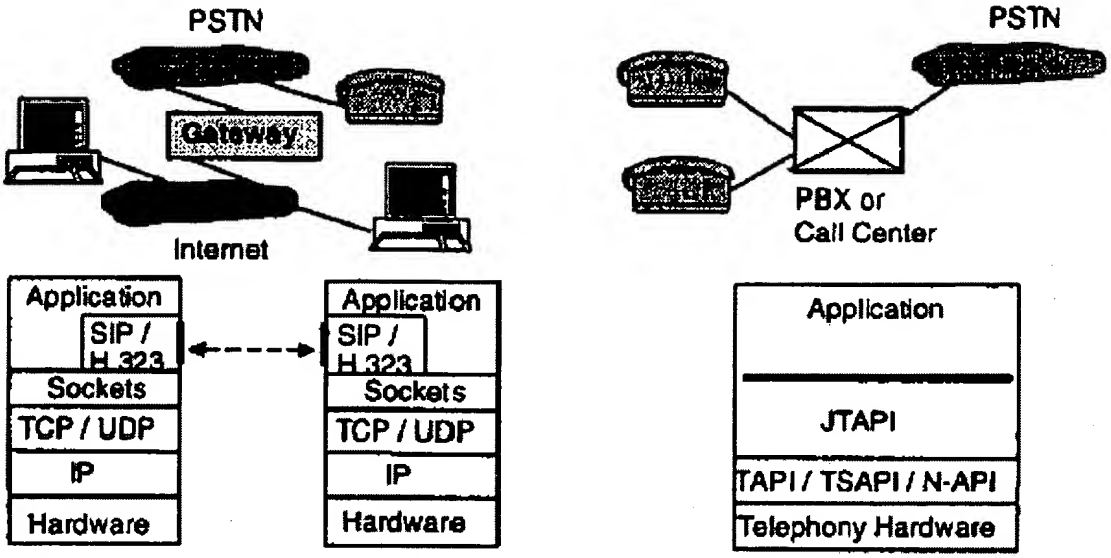

Figure 3 Internet Telephony (IT) vs. Computer-Telephony Integration (CTI) approaches

(ii) sending the SIP message and computer software code from the first SIP client associated with the first node to the second SIP client associated with the second node; (page 25, col.2, paragraph 2, "The issue of managing software components in ChaiTime is similar to that of managing applets and servlets in a Web based client-server environment ... if a Terminal Component is associated with the requested type, then the call can be immediately accepted and the component can be activated"; page 26, col.1, second paragraph, The CTI approach is oriented towards developing portable software for applications such as call centers, PBXs, etc. ...In contrast, the IT (Internet Telephony) approach (left side of Figure 3) is oriented towards developing protocols (e.g. SIP, H.323) that allow interoperability and communications between software running on user terminals or gateways"; Fig.4) and

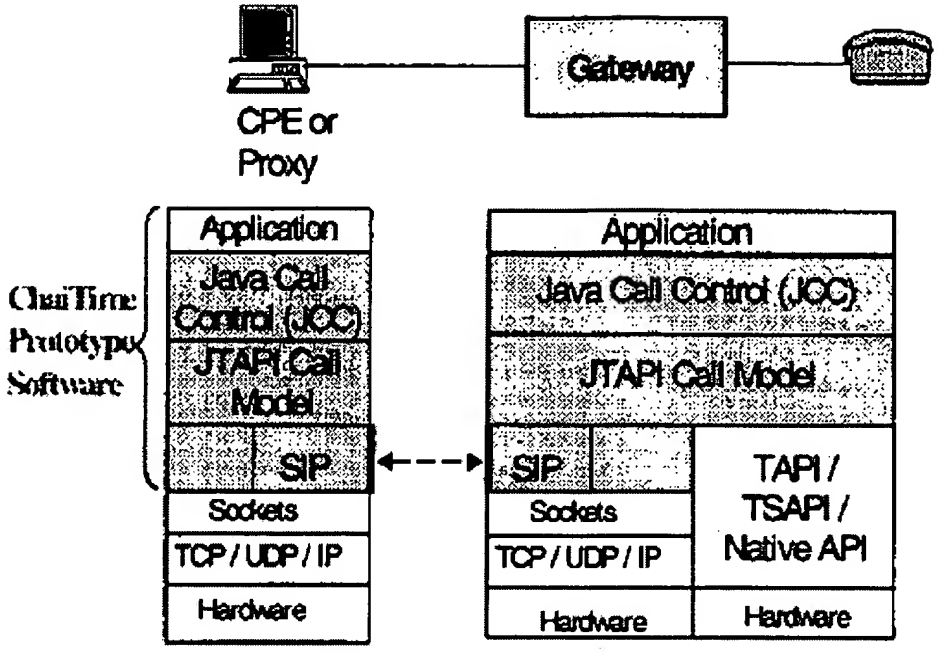

Figure 4 ChaiTime prototype software layers

(iii) executing the computer software using the second node. (page 26, col.1, second paragraph, ...the IT (Internet Telephony) approach (left side of Figure 3) is oriented towards developing protocols (e.g. SIP, H.323) that allow interoperability and communications between software running on user terminals or gateway"; Fig.6, Message flow for dynamic service download)

2. A method as claimed in claim 1 wherein said computer software code is added to the SIP message. (See Java Telephony API, JTAPI Core Model, page 26, col.2)

3. A method as claimed in claim 1 wherein said step of storing computer software code in the SIP message comprises adding an address to the SIP message which indicates where the computer software is stored. ("Objects in the JTAPI core call model")

4. A method as claimed in claim 3 wherein said address is a universal resource locator (URL). (page 24, col.2, "The ChaiTime architecture is based on a network of distributed, interconnected Providers White Endpoints have a single logical address, ...domains, and provider network connectivity...")

5. A method as claimed in claim 1 wherein said computer software code comprises Java byte code. (JTPAI address – Java Telephony API; JCC – Java Call Control Model)

6. A method as claimed in claim 1 wherein said computer software code comprises one or more Java applets. (page 25, col.2, paragraph 2, "The issue of managing software components in ChaiTime is similar to that of managing applets and servlets in a Web based client-server environment ... if a Terminal Component is associated with the requested type, then the call can be immediately accepted and the component can be activated")

7. A method as claimed in claim 1 wherein said computer software code comprises one or more mobile automated software agents.

8. A method as claimed in claim 7 wherein said mobile automated software agents are Java mobile agents. (page 26, col.1, see "ChaiTime call model")

9. A method as claimed in claim 1 wherein said second node comprises a Java virtual machine. (see "ChaiTime call model")

10. A method as claimed in claim 2, wherein the computer software code, is added to the body of the SIP message. (page 26, col.1, lines 1-29)

11. A method as claimed in claim 1, which further comprises adding an indicator to a header of the SIP message in order to indicate the presence of the computer software code and arranging the second SIP client to recognize the indicator. (page 26, col.1, lines 1-29)

12. A method as claimed in claim 1 which further comprises the step of proceeding with any SIP process related to the SIP message. (page 26, col.1, lines 1-29)

13. A method as claimed in claim 11 wherein said second SIP client is arranged such that on receipt of a SIP message containing such an Indicator, the computer software code stored in the SIP message is executed by the second node before that second node carries out any other processes related to the SIP message. (page 26, col.1-page 28, col.1, line 9)

14. A method as claimed in claim 1, wherein said computer software is arranged to interact with the second SIP client vial a specified application programming Interface. (User A, User B)

15. A method as claimed in claim 1 wherein said computer software is arranged to interact with a processor associated with the second SIP client via a specified application programming interface. (page 26, col.1, lines 1-29)

16. A method as claimed in claim 1 wherein said execution of said computer software code causes the second node to set up a multimedia conference call. (page 28, col.1, line 11-col.2, line 18)

17. A method as claimed in claim 1 wherein said execution of said computer software code causes the second node to upgrade or replace said SIP client. (page 26, col.1, lines 1-29)

18. A method as claimed in claim 1 wherein said execution of said computer software code causes the second node to test said second node. (as examiner's best understanding of claim 18; see page 26, col.1, lines 1-29)

19. A method as claimed in claim 1 wherein said execution of said computer software code causes said second node to collaborate with said first node to forward a call from the first to the second node. (as examiner's best understanding of claim 19; see page 26, col.1, lines 1-29)

20. A communications network node comprising: (Claim 20 is similarly rejected as in claim 1)
(i) a SIP client;
(ii) an input arranged to receive SIP messages;
(iii) a processor arranged to extract and execute-computer software code from a received SIP message.

21. A communications network node as claimed in claim 20 wherein said processor comprises a Java virtual machine. (ChaiTime system)

22. A communications network node as claimed in claim 20 which further comprises an application programming interface arranged to allow the computer software code to interact with the SIP client. (Claim 22 is similarly rejected as in claims 1-6)

23. A communications network node as claimed in claim 20 wherein said processor further comprises a detector arranged to detect an indicator in a received SIP message which indicates that computer software code is associated with that SIP message. (fig.7, State Machine of call events; EE1-EE8)

24. A computer program arranged to control a communications network node, said node comprising a SIP client and a processor, said computer program being arranged to control the node when executed on the processor such that when a SIP message is received by the SIP client, which contains computer software code, the software code is executed by the processor. (Claim 24 is similarly rejected as in claims 1)

25. A computer program as claimed in claim 24 which is stored on a computer readable medium. (ChaiTime system)

26. A communications network comprising a plurality of communications network nodes each such node comprising:

(i) a SIP client;

(ii) an input arranged to receive SIP messages containing computer software code; and

(iii) a processor arranged such that In use, when a SIP message is received, any computer software code contained In that SIP message is executed by the processor. (Claim 26 is similarly rejected as in claims 1)

27. A method of setting up a conference call between two or more parties, each party comprising a SIP client and a host processor, said method comprising the steps of

(I) storing computer software code in a SIP message;

(II) sending the SIP message to each of the parties;

(III) executing the computer software code at each of the host processors.

(Claim 27 is similarly rejected as in claims 1)

28. A method as claimed in claim 27 wherein the computer software code is arranged to take into account capabilities of each host processor. (Claim 28 is similarly rejected as in claims 1-7)

29. A method as claimed in claim 27 wherein said conference call is a multimedia conference call. (page 28, col.2, "The same address and Terminals share a number of active calls. Each call connection with the endpoint is represented by a different Connection and Terminal connection object.")

30. A system for automatically setting up a conference call between two or more parties, each party comprising a SIP client and a host processor, said system comprising:

a processor for storing computer software code

in a SIP message and to send that SIP message to each of the parties; and

wherein each of said host processors is arranged to execute the computer software code in use, when the SIP message is received. (Claim 30 is similarly rejected as in claims 1-10)

31. A method of upgrading or replacing interconnected SIP clients each SIP client being associated with a host processor said method comprising the steps of:

(i) storing computer software code suitable for said upgrade or replacement In a SIP message;

(ii) sending the SIP message to each of the SIP clients; and

(iii) executing the computer software at each of the host processors. (Claim 31 is similarly rejected as in claims 1-6)

32. A method of testing members of a group of SIP clients each SIP client being associated with a host processor said method comprising the steps

of:

(i) storing computer software code suitable for said testing in a SIP message;

(ii) sending the SIP message one of the SIP clients; (in executing tire computer software at the host processor associated with that SIP client in order to obtain test results; and

(iii) repeating steps (ii) to (iii) for each of the other SIP clients in the group. (Claim 32 is similarly rejected as in claims 1-12; also see page 29, col.1, "UML object model")

33. A method of forwarding a call from a first SIP client to a second SIP client, each of said SIP clients being associated with a host processor, said method comprising the steps of:
(i) receiving a call at the first SIP client and if that call is not answered then storing computer software code in a SIP message said computer software code being arranged to forward a call;
(ii) sending the SIP message from the first SIP client to a specified second SIP client and
(iii) executing the computer software using the host processor associated with the second SIP client such that the call is forwarded to the second SIP client. (Claim 33 is similarly rejected as in claims 1-13)

Response to Arguments

7. Applicant's arguments with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey C. Pwu whose telephone number is 571-272-6798. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

2/10/06

JEFFREY PWU
PRIMARY EXAMINER